

Appl. No. 09/304,552
Att. Docket No. 10191/3248
Reply To Final Office Action of 11/3/03

REMARKS

Claims 1 to 15 are now pending in the present application.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is therefore respectfully requested.

With respect to paragraph two (2), claims 1 to 15 were rejected under 35 U.S.C. § 103(a) as unpatentable over Tapp, U.S. Patent No. 5,657,076 in view of Johnson, U.S. patent No. 6,175,373.

While the rejections are not agreed with, to better clarify the subject matter of the claims, claim 1 as presented is directed to an observation system, including: an observation camera, and an observation monitor unit coupled to the observation camera, and including means for detecting for observation purposes a relevant event, *in which the observation monitor unit includes means for recording a plurality of images including an image at a time of the event occurring outside the observation system, and means for repeatedly displaying a sequence formed by the plurality of images upon the occurrence of the event.*

The Office Actions to date admit that the primary reference does not repeatedly display a sequence as recited in the context of the claim. The secondary Johnson reference does not cure this critical deficiency since even if it were proper to combine the reference (which it is not), the combination would not provide the above features or the security benefits of these features, as explained in the specification. Still further, the secondary reference does not concern security systems, and is only directed to providing buffers for a video system, in which only one of the video data portions in the buffer is selectively displayed to provide non-genlocked (non-synchronized) live video on a computer system. Thus, the secondary reference is directed to addressing an entirely different problem than is addressed by the presently claimed subject matter in which a sequence formed by a plurality of images is displayed upon occurrence of the event. Accordingly, a person having ordinary skill would not be motivated to combine the references to provide the presently claimed subject matter and its benefits, as explained in the specification.

Accordingly, claim 1 is allowable.

Regarding claims 2 to 4, 7, 10 and 13, which depend from claim 1, it is respectfully submitted that these claims are allowable for at least the same reasons as claim 1.

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Independent claims 5 and 6 as presented also include features like those of claim 1, and are therefore allowable for essentially the same reasons as claim 1.

Claims 8, 11 and 14 depend from claim 5 and are therefore allowable for the same reasons as claim 5.

Claims 9, 12 and 15 depend from claim 6 and are therefore allowable for the same reasons as claim 6.

As further regards the references relied upon, it is respectfully submitted that they likewise do not describe or even suggest means for performing the recited functions discussed above. (See M.P.E.P. §§ 2181 to 2184). In particular, M.P.E.P. § 2182 specifically states that both before and after In re Donaldson Co., 16 F.3d 1189, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994), applying a reference to a means-plus-function limitation “requires that the [referenced] element perform the identical function specified in the claim.” As explained, the systems of the references relied upon do not perform the recited functions, as recited in the context of the claims, as discussed above.

In this regard it is noted that the Office Actions do not address the fact that even if any of the references relied upon did disclose the function of the means recited in the claims -- which they do not as explained above, the Patent Office must meet its initial proof burden by showing that the referenced structure is the same as or equivalent to the structure described in the specification corresponding to the means as claimed. (See M.P.E.P. § 2182). It is believed and respectfully submitted that the referenced structure of the references relied upon is not the same as or equivalent to the structure described in the present application corresponding to the means as recited in the context of the claim. It is believed to be self-evident, for example, that the structures are not the same in view of the foregoing. In any event, the U.S.P.T.O. bears this proof burden, which has not been addressed in any way.

As further regard the obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also provide a motivation or suggestion for combining the elements in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”,

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Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998), which as referred to above simply do not address the problems met by the subject matter of any of the rejected claims.

In particular, the claimed subject matter is directed to solving the problem of having an observation system in which a detected relevant event is missed. This problem is solved by repeatedly displaying a sequence of images formed upon the occurrence of the detected event, including an image at the time of the event that occurs outside the observation system, so as to provide the benefit of drawing attention to the monitor. There is nothing in either of the references that in any way discloses or suggests how to solve the problem and/or provide the benefits resulting from the claimed subject matter.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Office Actions' assertions that it would have been obvious to modify the reference relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

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In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is respectfully submitted that the Office Actions to date reflect hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” -- which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the references relied upon. As referred to above, any review of the references, whether taken alone or combined, makes plain that they simply do not describe the features discussed above of the rejected claims.

More recent still, in the case of In re Lee, 61 U.S.P.Q.2d 1430, 1433-35 (Fed. Cir. 2002), the Court reversed the Board of Appeals for relying on conclusory statements, stating the following:

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The

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*examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. **This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority.*** It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

....

*In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. **Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.***

*[The] "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. **Conclusory statements such as those here provided do not fulfill the agency's obligation.***

[The] Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.

It is respectfully submitted that this is exactly what the Office has done here, since the conclusory Office Action statement (at page 4) that "Tapp and Johnson both suggest [sic] the monitor to display the image signal captured from the camera" is wholly deficient in meeting the evidentiary standard required by the Federal Circuit. The proper evidence must show why there is a suggestion to combine the references so as to provide the subject matter of the claims and its benefits. It is respectfully submitted that the proper evidence is not satisfied by showing that the system of the secondary reference may display different video data portions to provide non-genlocked (non-synchronized) live video on a computer system -- which has nothing to do with, for example, displaying a sequence formed by a plurality of images upon

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the occurrence of an event which *occurs outside of the observation system*, as provided for in the context of the claimed subject matter.

Still further, it is respectfully submitted that not even a *prima facie* case has been made in the present case for the obviousness rejections, since the Office Action never made any findings, such as, for example, regarding in any way what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard -- the evidence for which does not include “broad conclusory statements standing alone”. (See *In re Kotzab*, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art”, the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is respectfully submitted that there has been no such showings by the Office Action.

In fact, it is respectfully submitted that the present lack of any of the required factual findings forces both Applicants and any Appeals Board to resort to unwarranted speculation to ascertain exactly what facts underly the present rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Office bears the initial burden of presenting a proper *prima facie* unpatentability case. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

Accordingly, claims 1 to 15 are allowable for all of the above reasons.

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CONCLUSION

In view of the foregoing, it is believed that the rejections have been obviated, and that currently pending claims 1 to 15 are allowable. It is therefore respectfully requested that the rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,
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